

REMARKS

The issues outstanding in the Office Action mailed April 12, 2006, are solely the rejections under 35 U.S.C. §112. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

It is noted that claims 1-9, 11-13 and 17 have been indicated as being allowed.

Claim 14 has been rejected under 35 U.S.C. §112, first paragraph. Although applicants maintain the arguments presented previously concerning the sufficiency of the term "prodrug", the elimination of the term, made for business reasons unrelated to patentability, is submitted to obviate this issue. Withdrawal of the rejection of claim 14 under 35 U.S.C. §112, first and second paragraphs, is therefore respectfully submitted to be moot and withdrawal of thereof is respectfully requested.

Claim 10 has also been rejected under 35 U.S.C. §112, second paragraph, as the result of a typographical error. This issue has been eliminated by clarification of the claim.

It is finally noted that method claims 8-16 have been revised so as to permit R² to be hydrogen. It is respectfully submitted that none of the cited references disclose compounds, even those which are substituted by hydrogen in the 4-position, have utility, e.g., antigestaginic activity, which would thus suggest the treatment of the indications claimed in the present method claims. For example, Schubert '628 does not disclose the use of compounds for the treatment of hormonal disorders. Columns 2 and 3 of the patent disclose only the possibility that antigestagens have various hormonal and antihormonal properties. Concrete uses for treatment are disclosed at column 10, last passage, which do not comprise the treatment of hormonal disorders in postmenopausal women.

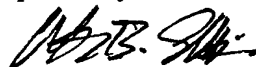
Schubert '582 does not disclose use of the compounds of the present invention including compounds which show hydrogen in the 4-Position (R₂=H). Instead, Schubert describes, at column 11, line 27 to 45, the use of compounds which are S-substituted, but does not disclose use of any compounds according to the present application. Claimed compounds (R₂=H) are only mentioned as, reactants to obtain the S-substituted compounds. It is not possible to generalize from the properties of the S-substituted compounds to the properties of the reactants;

moreover, such is contrary to applicable U.S. law. For example, see *In re* Lalu, 223 U.S.P.Q. 1257 (Fed. Cir. 1984) and *In re* Gyurik, 201 U.S.P.Q. 552 (CCPA 1979), each of which holds that it is impermissible to modify material disclosed only as an intermediate in the production of other compounds, with the expectation that such a compound would have any utility. Both cases state that the only utility of an intermediate compound, in the patent sense, is to make a final compound. Thus, the presently claimed methods are *not* obvious over the disclosure of the 4-hydrogen intermediate compound, used only to produce end materials.

Accordingly, it is submitted that the claims in the application are in condition for allowance, and passage to issue is respectfully requested. However, if the Examiner has any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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